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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,680	10/23/2001	Shell S. Simpson	10008087-1	7279

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/032,680	Applicant(s) SIMPSON ET AL.	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-21 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 11/18/05, and has been entered and made of record. Currently, **claims 13-21, and 26-31** are pending.

Response to Arguments

2. Applicant's arguments, see pages 5-11, filed 11/18/05, with respect to the rejection(s) of claim(s) 13-21, and 26-31 under 35 U.S.C. 102(e) as being clearly anticipated by Kaufman et al. (U.S. Patent Application Publication 2002/0163662), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Yoshino *et al.* (U.S. Patent Application Number 2001/0042117).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 13, 16, and 26-28** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13, 16, and 26-28 include functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

In each of claims 13, 16, and 26-28, while defining a program, do not define a “computer-readable medium” and is thus non-statutory for that reason. A program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claims statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 13-21, and 26-31** are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshino *et al.* (U.S. Patent Application Number 2001/0042117).

Regarding **claim 13**, Yoshino discloses a server, comprising means for receiving a request from a client (paragraph 0010), and means for responding to the request by transmitting a program of instructions to the client (paragraphs 0010 and 0027), the program for enabling the client to initiate the printing of a document by a printer (paragraph 0055), detect if the printer encounters an alert condition while printing a document (paragraph 0027), and if an alert condition is detected, display a selectable object for initiating a performance by the client of a specified function (paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding **claim 14**, Yoshino discloses the server discussed above in claim 13, and further teaches that the object is a hyperlink (see Figs. 5-9, paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding **claim 15**, Yoshino discloses the server discussed above in claim 14, and further teaches that the function is for assisting a user of the client in resolving the alert condition (see abstract, and paragraphs 0013-0016, 0031, 0066-0068, 0077, and 0086-087).

Regarding *claim 16*, Yoshino discloses the server discussed above in claim 14, and further teaches of means for receiving input, from a system administrator, that defines a hyperlink and associates the hyperlink to a particular type of printer alert condition (see Figs. 5-9, paragraphs 0031-0032, 0066-0068, 0077, and 0086-087), and wherein the program of instructions is further for enabling the client to display the defined hyperlink if the client detects that the printer has encountered the particular type of alert condition (paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding *claim 17*, Yoshino discloses the server discussed above in claim 14, and further teaches that the hyperlink refers to a Web page that provides helpful information for resolving the type of error condition detected (see Figs. 5-9, paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding *claim 18*, Yoshino discloses the server discussed above in claim 14, and further teaches that the alert condition is a paper jam condition and the hyperlink refers to a Web page that provides information regarding how to clear a paper jam in the printer (see Fig. 7, paragraphs 0078-0080).

Regarding *claim 19*, Yoshino discloses the server discussed above in claim 14, and further teaches that the alert condition is a low consumable condition and the specified function facilitates the purchase of a replacement consumable (see Fig. 5, paragraphs 0067-0068).

Regarding *claim 20*, Yoshino discloses the server discussed above in claim 14, and further teaches that the hyperlink is configured to facilitate communication between the client user and a specific individual (see Figs. 5-9, paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding *claim 21*, Yoshino discloses the server discussed above in claim 13, and further teaches that the server is incorporated within the printer (paragraphs 0027-0032, 0055, and 0089-0090).

Regarding *claim 26*, Yoshino discloses a server, comprising apparatus for responding to a pre-defined request received from a client by transmitting a program of instructions to the client (paragraphs 0010 and 0027-0032), the program for enabling the client to detect if the printer encounters an alert condition while printing a document (paragraph 0027), and if an alert condition is detected, display a hyperlink for initiating a performance by the client of a specified function for assisting a user in resolving the alert condition (paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding *claim 27*, Yoshino discloses the server discussed above in claim 26, and further teaches that the program further enables the client initiate the printing of the document by the printer (paragraphs 0010, 0027-0032, and 0087-0090).

Regarding *claim 28*, Yoshino discloses a printing system (see Figs. 1-11), comprising a printer operable to print a document (paragraph 0055) and serve a program of instructions to a client (paragraphs 0010 and 0027-0032), a client operable by a user to request the program from the printer (paragraphs 0010 and 0027-0032), the program enabling the client to initiate the printing of a document using the printer (paragraph 0055), if the printer encounters an error condition while printing the document (paragraph 0027), display a hyperlink (see Figs. 5-9) for initiating a performance by the client of a specified function to assist the client user in resolving the alert condition (paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Regarding *claim 29*, Yoshino discloses the printing system discussed above in claim 28, and further teaches that the client is a personal digital assistance (PDA) (paragraphs 0099-0104).

Regarding *claim 30*, Yoshino discloses the printing system discussed above in claim 28, and further teaches that the client is a personal computer (paragraphs 0054-0058).

Regarding *claim 31*, Yoshino discloses the printing system discussed above in claim 28, and further teaches that the hyperlink refers to a Web page that provides helpful information for resolving the specific type of error condition encountered by the printer (see Figs. 5-9, paragraphs 0031-0032, 0066-0068, 0077, and 0086-087).

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Bernklau-Halvor (U.S. Patent Application Publication 2003/0110413) discloses a method for analyzing printer faults.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622

A handwritten signature in black ink, appearing to read "Joseph R. Pokrzywa", written in a cursive style.

jrj